

### **AMENDMENTS TO THE DRAWINGS**

The drawings were objected to "because Figure 30B illustrates an embodiment of the invention but contains no detail in reference to the specification." Figure 30B was inadvertently included in the application and, therefore, the Applicants hereby request that Figure 30B be removed from the application. The Applicants have made proper amendments to the specification, listed in a preceding section of this response.

The Applicants have included a new drawing figure, numbered as Figure 23A, to correct informality in the disclosure. Figure 23A comprises the graph located after paragraph [00178]. The Applicants have properly labeled the graph in Figure 23A and have amended the necessary portions of the specification corresponding to the new Figure 23A. The Applicants submits that no new matter has been entered by the new Figure 23A and by the amendments to the specification.

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-18 and 36-40. Claims 1-3, 5-8, 10, 16-18, and 36-40 have been rejected. Claims 4, 9, and 11-15 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. By this Amendment, claims 1, 36, and 39 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicants respectfully submit that the claims define patentable subject matter.

Initially, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicants assume, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1, 2, 17, 18, and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,737,430, issued to Widrow ("Widrow"). Claims 39 and

40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 6,307,945, issued to Hall ("Hall"). Claims 3, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of Valente, "Hearing Aids: Standards, Options, and Limitations," 1996 ("Valente"). Claims 6-8, 10, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of US Patent No. 6,320,959, issued to Crouch, et al. ("Crouch"). The Applicants respectfully traverse these rejections at least for the reasons previously set forth during prosecution and the following remarks:

## **REJECTIONS UNDER 35 U.S.C. § 102**

### **I. Widrow Does Not Anticipate Claims 1, 2, 17, 18, and 36**

The Applicants first turn to the rejection of claims 1, 2, 17, 18, and 36 under 35 U.S.C. 102(b) as being anticipated by Widrow. With regard to the anticipation rejections under 102(b), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

#### **A. Rejection of Independent Claims 1 and 36 under 35 U.S.C. § 102 (b)**

With regard to the rejection of independent claim 1 under Widrow, the Applicants submit that Widrow does not disclose or suggest at least the limitation of “at least one inductor for converting the second electrical signal into a magnetic field for coupling to at least one telecoil of a hearing aid ... wherein said at least one inductor comprises a plurality of coils,” as recited by the Applicants in independent claim 1. The Office Action refers for support to item 22 of Widrow. See the Office Action at page 3. The Applicants would like to point out that Widrow discloses that the “output of the power amplifier can be used to drive neck loop 9 to generate magnetic flux 22.” See Widrow, col. 3, lines 21-23. In this regard, item 22 is a magnetic flux and it is not an inductor, as implied by the Examiner’s argument in the Office Action. Furthermore, the Applicants submit that item 9 is a neck loop and not an inductor, as recited by the Applicants in claim 1. Also, the neck loop 9 does not comprise a plurality of coils, as recited by the Applicants in claim 1. Therefore, the Applicants submit that independent claim 1 is not anticipated by Widrow and is allowable.

Independent claim 36 is similar in many respects to the device disclosed in independent claim 1. Therefore, the Applicants submit that independent claim 36 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2, 17, and 18**

Based on at least the foregoing, the Applicants believe the rejection of independent claims 1 and 36 under 35 U.S.C. § 102(b) as being anticipated by Widrow

has been overcome and request that the rejection be withdrawn. Additionally, claims 2, 17, and 18 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 1, 2, 17, 18, and 36.

## **II. Hall Does Not Anticipate Claims 39 and 40**

The Applicants next turn to the rejection of claims 39-40 under 35 U.S.C. 102(b) as being anticipated by Hall.

### **A. Rejection of Independent Claim 39 under 35 U.S.C. § 102 (b)**

With regard to the rejection of independent claim 39 under Hall, the Applicants submit that Hall does not disclose or suggest at least the limitation of “at least one inductor for converting the second electrical signal into a magnetic field for coupling to at least one telecoil of a hearing aid ... wherein said at least one inductor comprises a plurality of coils,” as recited by the Applicants in independent claim 39. The Office Action refers for support to item 7 of Hall. See the Office Action at page 4. The Applicants would like to point out that Hall discloses that “a signal passes into ... the induction loop 7, which passes to a hearing aid ear-piece...” See Hall, col. 5, lines 10-12. In this regard, item 7 is an induction loop, also known in the art as a “neck loop.” The Applicants submit that the loop 7 of Hall does not comprise a plurality of coils, as

recited by the Applicants in claim 39. Therefore, the Applicants submit that independent claim 39 is not anticipated by Hall and is allowable.

**B. Rejection of Dependent Claim 40**

Based on at least the foregoing, the Applicants believe the rejection of independent claim 39 under 35 U.S.C. § 102(b) as being anticipated by Hall has been overcome and request that the rejection be withdrawn. Additionally, claim 40 depends from independent claim 39, and is, consequently, also respectfully submitted to be allowable.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 39-40.

**REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

### **III. Widrow Does Not Render Claims 3, 37, and 38 Unpatentable**

Claims 3 is dependant on claim 1 and claims 37-38 are dependant on claim 36. Therefore, the Applicants submit that claims 3, 37-38 are allowable over the references cited in the Office Action at least for the reasons stated above with regard to the allowability of independent claims 1 and 36.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 3, 37 and 38.

**IV. The Proposed Combination of Widrow and Valente Does Not Render Claim 5 Unpatentable**

Claims 5 is dependant on claim 1. Therefore, the Applicants submit that claim 5 is allowable over the references cited in the Office Action at least for the reasons stated above with regard to the allowability of independent claim 1.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claim 5.

**V. The Proposed Combination of Widrow and Crouch Does Not Render Claims 6-8, 10, and 16 Unpatentable**

Claims 6-8, 10, and 16 are dependant on claim 1. Therefore, the Applicants submit that claims 6-8, 10, and 16 are allowable over the references cited in the Office Action at least for the reasons stated above with regard to the allowability of independent claim 1.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 6-8, 10, and 16.

**VI. Allowable Subject Matter**

The Applicants acknowledge with appreciation the Examiner's statement that dependent claims 4, 9, and 11-15 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. New claims 41-47 have been added, which correspond to dependant claims 4, 9, and 11-15,



respectively. The new claims 41-47 were rewritten in independent form including all of the limitations of the base claims and any intervening claims and are, therefore, respectfully submitted to be allowable.

**CONCLUSION**

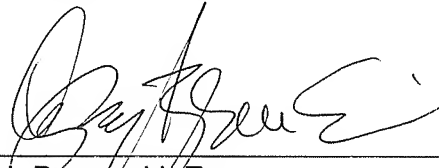
Based on the foregoing, the Applicants believe that all claims 1-18 and 36-47 are in condition for allowance. If the Examiner disagrees, the Applicants respectfully request a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

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Respectfully submitted,



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## Appendix